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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,391	03/09/2004	David M. Giuntoli	212/333USC1	1896

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EXAMINER
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HOLMES, REX R

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/796,391	Applicant(s) GIUNTOLI ET AL.	
	Examiner Rex Holmes	Art Unit 3762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/09/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,735,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are narrower and meet the limitations of the broader application claims. They both claim electro-acupuncture device containing a housing, electrodes, a band, a pulse generator, and a gasket.

***Claim Rejections - 35 USC § 103***

3. Claim 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over GRUZDOWICH (U.S. Pat. 6,178,352) in view of RASMUSSEN (U.S. Pat. 4,524,775).

Art Unit: 3762

4. Regarding Claims 16, 19, 22, and 23, GRUZDOWICH discloses a band attached to the housing and said band adapted to secure the housing to the body (Fig. 1, Column 2, Lines 20-25) as a means to securely hold in place the electrodes to the body and a pulse generating circuitry housed within the housing and said pulse generating circuitry operably connected to the electrodes to provide electrical pulses to the nerve through electrodes (Column 2, Lines 20-25) as a means to provide stimulation to the body near the P6 acupuncture point (Column 2, Lines 23-25). But, GRUZDOWICH fails to disclose a gasket to receive the electrodes. However RASMUSSEN discloses a gasket having at least one aperture, said aperture being sized and dimensioned to receive the electrodes, said gasket disposed about the electrodes on the bottom outer surface of the housing (Figure 2, Column 4, Lines 1-8). In addition RASMUSSEN discloses that the thickness of the gasket is greater than that of the electrode, but also when compressed would not impede direct contact between the electrodes and the patient (Column 4, Lines 1-8).

5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of GRUZDOWICH to include a gasket having at least one aperture, said aperture being sized and dimensioned to receive the electrodes, said gasket disposed about the electrodes on the bottom surface of the housing, as taught by RASMUSSEN, as a means to seal the electrodes to the housing by creating a contact medium chamber and to create an increased connection between the electrodes and the patient.

6. Regarding Claims 17-18, 20-21, and 24-25, GRUZDOWICH in view of RASMUSSEN discloses the claimed invention except for the gasket being neoprene or silicone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the gasket as taught by GRUZDOWICH, with a neoprene or silicone gasket since it was known in the art that neoprene or silicone is an inexpensive conventional material to provide a tight seal with the body, which helps with the electrode connections.

7. Alternatively, GRUZDOWICH in view of RASMUSSEN discloses the claimed invention but does not disclose expressly the use of neoprene or silicone for the gasket. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the gasket as taught by GRUZDOWICH in view of RASMUSSEN with the gasket comprising neoprene or silicone, because the Applicant has not disclosed that the gasket composition provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with gasket as taught by GRUZDOWICH in view of RASMUSSEN, because it provides securement to an apparatus and since it appears to be an arbitrary design consideration which fails to patentably distinguish over GRUZDOWICH in view of RASMUSSEN.

Therefore, it would have been an obvious matter of design choice to modify gasket of GRUZDOWICH in view of RASMUSSEN to obtain the invention as specified in the claim(s).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rex Holmes whose telephone number is 571-272-8827. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rex Holmes

8/21/06



George Evanisko

Primary Examiner

8/21/06